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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/323,636	06/01/1999	JAMES E. BARRY	8688.6808	9457
44538	7590	06/01/2005	EXAMINER	
DANIEL S. POLLEY, P.A. 1215 EAST BROWARD BOULEVARD FORT LAUDERDALE, FL 33301			LEE, Y MY QUACH	
			ART UNIT	PAPER NUMBER
			2875	

DATE MAILED: 06/01/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/323,636

Applicant(s)

BARRY, JAMES E.

Examiner

Y Quach Lee

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 April 2005.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 17-23, 25, 26 and 28-33 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 26, 28 and 30-33 is/are allowed.
- 6) ☒ Claim(s) 17, 18, 20-23, and 25 is/are rejected.
- 7) ☒ Claim(s) 19 and 29 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Response to Arguments

1. Prosecution on the merits of this application is reopened. The finality of the Office action of October 8, 2003 is withdrawn. The indicated allowability of claims 17, 18, 20 to 23 and 25 is withdrawn in view of the references to Carlson, Helm and Lichon et al. Applicant's arguments of January 16, 2002 and July 30, 2002 with respect to the references of Carlson and Lichon et al. in view of Helm have been fully considered but they are not persuasive. Applicant states that Carlson requires a low intensity light bulb and the low intensity bulb is required to avoid distraction to the rider while driving and thus, would not provide enough light to illuminate the surroundings. It should be noted that since the body member of Carlson is transparent, this allows the light from the illumination member to provide enough light to illuminate the surrounding. Also, Applicant's attention is directed to column 3, lines 10 to 11 which state that the illumination member, in some measure acting to make the vehicle more visible to others. Accordingly, rejections based on the cited reference follow. With regards to the references of Lichon et al. and Helm, applicant also states that attaching the illumination member to the tank not the post would affect third parties visibility of the illumination member, one would not be motivated to move the illumination member so that it is attached to the gasoline tank, and also the gasoline tank of Helm is different than a motorcycle gasoline tank. It should be noted that although the gasoline tank (11) of Helm is different from the motorcycle gasoline tank, the reference of Helm is not only cited to show the teaching of attaching the illumination member to the gasoline tank (11), but is also cited to show the teaching of attaching the illumination member to other various gas tanks (column 4, lines 17 to 18) or to a metal curved surface (column 1, last line) or irregular metal wall (40) of the vehicle. The reference of Helm is not cited to show the teaching of moving the illumination member from the post to the tank. One skilled in the art would therefore be motivated to attach an illumination member to the gasoline tank of Lichon et al. in view of the teaching of Helm for further improving the visibility of the vehicle. Accordingly, rejections based on the cited references follow.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

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A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 17 and 21 are rejected under 35 U.S.C. 102(b) as being anticipated by Carlson (prior art previously cited).

Carlson shows a body member (10) shaped as a motorcycle gasoline tank and adapted for attachment to the frame (11) of the motorcycle where a conventional motorcycle gasoline tank is normally disposed, an illumination member (40) secured to the body member, means (50) for energizing the illumination member, and note that since the body member is transparent, this allows the light from the illumination member to illuminate an adjacent side and front ground area around the motorcycle.

4. Claims 22 and 25 are rejected under 35 U.S.C. 102(b) as being anticipated by Carlson (prior art previously cited).

Carlson shows a method of providing a body member (10) in the shape of a motorcycle gasoline tank which is attached to the frame (11) of the motorcycle where a conventional motorcycle gasoline tank is normally disposed, securing an illumination member (40) to the body member, providing means (50) for energizing the illumination member, and since the body member is transparent, it allows the light from the illumination member to illuminate an adjacent side and front ground area around the motorcycle.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 17, 18, 20 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lichon et al. (prior art previously cited) in view of Helm (prior art previously cited).

Lichon et al. disclose a body member shaped as a motorcycle gasoline tank (figure 1) and adapted for attachment to the frame (figure 1) of the motorcycle where a conventional motorcycle gasoline tank is normally disposed, the body member defined by a front half portion being closer to a front area of the motorcycle, and a back half portion. However, Lichon et al. do

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not disclose an illumination member secured to the body member such as secured to the front half portion of the body member, means for energizing the illumination member and the illumination member performing the function of a turn signal.

Helm teaches a flexible illumination member (figure 7) which may be utilized for securing to a gas tank (11), for mounting on various gas tanks (column 4, lines 17 to 18) or for securing to a metal curved surface (column 1, last line) or irregular wall (40) of the vehicle so that the illumination member can conformingly attach to various gas tanks with irregular or curved metal surfaces found on a vehicle without substantially modification of the vehicle walls such as drilling various holes through the vehicle walls while facilitating the mounted and demounted of the illumination member to and from the vehicle to improve the visibility of the vehicle toward the surrounding. Helm also teaches means (column 3, line 66) for energizing the illumination and the illumination member performing the function of a turn signal (column 3, line 64).

It would have been obvious to one skilled in the art to secure the illumination member to the body member of Lichon et al., in view of the teaching of Helm, to facilitate the mounted and demounted of the illumination member to and from the vehicle body member without substantially modification of the vehicle walls such as drilling various holes through the vehicle walls while further improving the visibility of the vehicle.

Note that since the flexible illumination member of Helm can be used to mount on various gas tanks or irregular curved walls, mounting or securing the illumination member to the front half portion of the body member such as a motorcycle gasoline tank of Lichon et al. to improve the visibility of the motorcycle toward the surrounding would have been obvious to one skilled in the art.

7. Claims 22, 23 and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lichon et al. (prior art previously cited) in view of Helm (prior art previously cited).

Lichon et al. disclose a body member shaped as a motorcycle gasoline tank (figure 1) and adapted for attachment to the frame (figure 1) of the motorcycle where a conventional motorcycle gasoline tank is normally disposed, the body member defined by a front half portion being closer to a front area of the motorcycle, and a back half portion. However, Lichon et al. do

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not disclose a method of securing an illumination member to the body member such as securing to the front half portion of the body member, and means for energizing the illumination member.

Helm teaches a method of securing a flexible illumination member (figure 7) to a gasoline tank (11), to various gas tanks (column 4, lines 17 to 18) or to a metal curved surface (column 1, last line) or irregular wall (40) of the vehicle so that the illumination member can conformingly attach to various gas tanks with irregular or curved metal surfaces found on a vehicle without substantially modification of the vehicle walls such as drilling various holes through the vehicle walls while facilitating the mounted and demounted of the illumination member to and from the vehicle to improve the visibility of the vehicle toward the surrounding. Helm also teaches means (column 3, line 66) for energizing the illumination.

It would have been obvious to one skilled in the art to Lichon et al. a method of securing the illumination member to the body member of the vehicle, in view of the teaching of Helm, to facilitate the mounted and demounted of the illumination member to and from the vehicle body member without substantially modification of the vehicle walls such as drilling various holes through the vehicle walls while improving the visibility of the vehicle.

Note that since the flexible illumination member of Helm can be used to mount on various gas tanks or irregular curved walls, providing Lichon et al. with the method of mounting or securing the illumination member to the front half portion of the body member such as a motorcycle gas tank to improve the visibility of the motorcycle would have been obvious to one skilled in the art.

8. Claims 19 and 29 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

9. Claims 26, 28 and 30 to 33 are allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Y Quach Lee whose telephone number is 571-272-2373. The examiner can normally be reached on Tuesday and Thursday from 8:30 am to 4:30 pm.

Any inquiry of a general nature or relating to the status of this application or proceeding

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should be directed to the Customer Service whose telephone number is 571-272-2815.

Y. Q.
May 19, 2005



Y Quach Lee
Patent Examiner
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